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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,734	07/31/2000	Thomas Elliot Rabe	7730R	4129

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EXAMINER

NGUYEN, HELEN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/629,734

Applicant(s)

RABE ET AL.

Examiner

Helen Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 22-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The election of paper no. 10, filed 11/20/2001, is acknowledged.

In view of the Applicants' traversal of the restriction requirement in paper no. 10, the Examiner restates the restriction as follows:

Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1-12, drawn to a method, classified in class 514, subclass 1+.
- II. Claims 22-23, drawn to an apparatus and a method for using the apparatus, classified in class 401, subclass 190.

The inventions are distinct, each from the other because:

Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice such as an electrostatic spraying apparatus for graphic work, for example, an airbrush.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

If Applicants elect Group I, then the following elections of species are required:

*U62 AR 16  
§ 101 (a)(1)* Claim 6 is generic to a plurality of disclosed patentably distinct species comprising insulating material of the external phase. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Applicants must elect a class of compound in claim 6 species of which are recited in claims 7-9, Applicants must elect one species from claims 7-9.

*reppent 6-4-00*  
Claim 13 is generic to a plurality of disclosed patentably distinct species comprising conductive materials of the internal phase. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicants must elect one ultimate species, for example, if Applicants elect a class of compound in claim 11 species of which are recited in claims 12-16, Applicants must elect one species from claims 12-16.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an

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inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

During a telephone conversation with Attorney Dara M. Kendall on Friday January 04, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21; the elected species are volatile silicones (claim 6) and propylene glycol (claim 13). Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-9 and 22-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-7, and 10-21 are presented for examination.

### ***IDS***

The Information Disclosure Statement or PTO form 1449 filed on December 11, 2000, was not considered because of missing a PTO form 1449 and prior art.

### ***Claim rejection***

❖ The following is a quotation of the **second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, and 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*maintain* In claim 1, the phrase "treating the skin" is vague. What is the purpose of the treatment of the skin? For a disorder?

*moot* In claim 4, "0.2" for the external phase is indefinite because the external phase for this value is smaller than internal phase.

❖ The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (US Patent No. 5,494,674) in view of Masuda (WO 98/26752).

Barnett et al. teach an electrostatic spraying system for skin treatment agents. Cost effectiveness, safety, and evenness of coverage on

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the skin surface during application is disclosed (abstract; column 1, lines 6-10; column 2, lines 55-63; column 3, lines 45-46; and column 4, line 45).

The skin treatment vehicles for cosmetics or pharmaceutical purposes include creams (abstract). Skin conditioning agents, skin cleansers, skin nutrients or healing agents, anti-aging agents, skin coloring agents, and moisturizers are specified (column 4, lines 5-38). <sup>*Int. phase*</sup> Propylene glycol is specified (column 4, line 56). A flow rate, a voltage, and an application rate of the electrostatic spray are specified (column 6, lines 28-31, 50-53; and column 8, lines 35-37).

Barnett et al. do not teach an emulsion composition containing volatile silicones.

Masuda teaches a an emulsion composition comprising:

- up to about 90% of volatile silicones as an external phase; and
- up to about 30% of propylene glycol as an internal phase (abstract; page 3, lines 34-37 bridging page 4, lines 1-6, line 10; and page 7, line 23).

The composition further comprises emulsifiers (page 5, line 14).

Silicones viscosities under 10,000 cSt are specified (page 4, lines 19-20, 26-27 and 36).



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It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to deliver the composition of Masuda to achieve the beneficial effect of cost effectiveness, safety, and evenness of coverage on the skin surface during application by using an electrostatic spray in view of Barnett et al.

As to the claimed solid, Applicants "or less" include zero.

Claims 1-7, and 10-21 are rejected.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen

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Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on M-F (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Edward J. Webman can be reached at (703) 308-4432 or her supervisor, Minna Moezie can be reached at (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Helen Nguyen  
Patent Examiner

January 22, 2002

EDWARD J. WEBMAN  
PRIMARY EXAMINER  
GROUP 1500